

REMARKS

Status of the Claims

Claims 17-29 and 33 are pending in this application and stand ready for further action on the merits.

Provisional Request for Interview

Should the present response not result in an allowance of each of the pending claims 17-29 and 33, the Examiner is respectfully requested to contact the undersigned so that a personal interview may be scheduled at the Examiner's earliest convenience in order to allow the present case to proceed towards allowance without any additional prosecution delay.

Enclosed Documents

Enclosed with the present response are 11 separate documents as listed in Table 1, which is also enclosed herewith. Also enclosed is a copy of **International Cosmetics Ingredient Dictionary**, Vol. 210, pages 488-489, 521-522 (1993).

The enclosed documents are being provided to support Applicant's position with regard to clarifying the meaning of the

term "dimmer diol" which is used at column 4, line 49 of the Ansmann US 5,795,978 reference.

Rejections Under 35 U.S.C. § 103(a)

The Examiner rejects claims 17-20, 22-29 and 33 as obvious over Ansmann US 5,795,978 (Ansmann '978) in view of Akrongold US 3,846,550 (Akrongold '550). The Examiner also rejects claim 21 as obvious over Ansmann '978 in view of Akrongold '550 and further in view of Bernhardt US 4,788,054 (Bernhardt '054). Applicants traverse the rejection and respectfully request withdrawal thereof.

First, the Examiner relies on Ansmann '978 for disclosing an emulsifier used in the production of cosmetic formulations. However, Applicants submit that Ansmann '978 does not disclose a dimmer acid. Ansmann '978 discloses an emulsifier that is a mixture of alkyl and/or alkenyl oligoglycoside and fatty alcohols. The emulsifier is not a fatty acid ester and has no relation to a dimerdiol ester. Moreover, the oil in Ansmann '978 is an oil constituting an O/W type emulsion (see column 4, lines 39-40) and not an emulsifier (as previously suggested by the Examiner).

Ansmann discloses at column 3 under the heading of "Commercial Applications" that:

"[t]he emulsifiers according to the invention enable stable o/w emulsions to be produced. In contrast to known emulsifiers, which have a higher fatty alcohol content and a lower glucoside content, highly viscous creams, for example may even be produced with low wax concentrations which results in a significant improvement in the sensorial properties of the product."

Ansmann notes that the improvement in the sensorial properties is attributable to the emulsifier and not the use of oil alone. From this passage one of ordinary skill in the art would know that the oils disclosed at column 4, lines 39-56 will not produce the improved sensorial properties alone. The improvement is only achieved when the oil is used in conjunction with the emulsifier.

As such, Applicants submit that one of ordinary skill in the art would not be motivated to replace the alcohol moieties of the esters of fatty acids disclosed in Akrongold at column 1, lines 56-61 with dimerdiol to arrive at a cosmetic composition.

Second, the cosmetic composition of Ansmann is completely different from the cosmetic of Akrongold. The number of carbon atoms is different in the different compositions. As such, one of ordinary skill in the art would not be motivated to combine the

references. For this additional reason, Ansmann cannot be combined with Akrongold to arrive at the present invention.

Third, Applicants submit that the term "dimerdiol" that occurs at column 3, lines 14-17 of Ansmann '978 is distinct and different from the term "dimer diol" disclosed at column 4, line 49 of Ansmann '978, with the two terms referring to entirely different compounds. For example, while the former "dimerdiol" possesses a generic meaning that would encompass the use of the term "dimerdiol" in the instant invention, the later term "dimer diol" does not. The dimer diol used in the cited art of Ansmann is merely disclosed as belonging to polyols and there is no suggestion that it is related to a dimerdiol of the instant invention. Moreover, it appears that a "dimer diol" as used in Ansmann is represented by the formula **HO-Ar-O-Ar-OH**, wherein Ar is ethylene.¹

Upon review of Table 1 attached hereto, and a review of the patents 1-8 listed thereon which resulted from a patent database search of the terms "dimer diol" and "trimer diol", the Examiner will see that in each of the patents 1-8 "dimer diol" is mentioned in a paragraph formulated in much the same way as it occurs in Ansmann '978, along with the term "trimer diol". Thus, it is not

¹ It also appears that trimer diol is represented by the formula HO-Ar-O-Ar-O-Ar-H, wherein Ar is ethylene.

merely a typographical error that allows Ansmann to use "dimerdiol" at column 3 thereof, lines 15-17, and simultaneously the chemically distinct term "dimer diol" at column 4, line 49. Instead it is a purposeful use of two distinct terms to refer to two distinct chemical entities.²

Similarly, in the patents 10-11 listed in Table 1, the terms "dimer diol" and "trimer diol" are disclosed, and are polysiloxanes and oligomers of terephthalic acid ester. In view of these disclosures in the patents 1-8 and 10-11 of Table 1, it is increasingly clear that the Ansmann '978 disclosure at column 4, line 49 in no ways teaches or provides for the use of an acid ester of a dimerdiol, as is required in the instant invention.

As further examples of dimer diols (and trimer diols), applicants also wish to bring the Examiner's attention to the following enclosed reference *International Cosmetics Ingredient Dictionary, Vol. 210 (1993)*, issued by the CTFA. In the reference, PEG-2 stearate, PEG-3 stearate, PEG-2 distearate and PEG-3 distearate are disclosed. PEG-2 is a typical dimer diol used in the

² In the patent listed as No. 3 in Table 1 (US 6,033,652) esters of diethyleneglycol or triethyleneglycol with an aliphatic acid, which are also a dimer diol and a trimer diol, respectively, are disclosed at column 4, lines 39-54. These compounds were mentioned for sake of clarifying the terms "dimer diol" and "trimer diol" in the Applicants earlier response.

cosmetic industry, while **PEG-3** is a typical trimer diol used in the cosmetic industry.

Thus, while a "dimer diol" as used in Ansmann is known for uses in cosmetics, it is not equal to or equivalent to a "dimerdiol" of the present invention.

Forth, Ansmann '978 fails to disclose any specific compounds that are esters of linear and/or branched fatty acids with polyhydric alcohols, such as esters of "dimer diol". Ansmann '978 also clearly fails to disclose esters of dimerdiols, even if *arguendo*, it may generically disclose or suggest a dimerdiol at column 3, lines 15-17, as mentioned above.

Accordingly, upon a review of the disclosure of Ansmann '978 at column 3, lines 15-17 and column 4, line 49, the only material fact that Ansmann '978 fairly teaches therein is that a "dimer diol" is not identical to a "dimerdiol".

Fifth, Akrongold '550 discloses a cosmetic skin powder containing urea, an oil phase and an inorganic pigment. The oil is disclosed as being acids and alcohols containing 5 to 52 carbon atoms. Specifically disclosed oils are esters of fatty acids as a genus, and limited numbers of fatty acid esters including isopropyl myristate and hexadecyl stearate. These specific examples are

outside the scope of the esters of the present invention. Moreover, since the disclosure of Akrongold '550 fails to disclose or suggest polyhydric alcohols, it also fails to teach or suggest to those of ordinary skill in the art the dimerdiol esters of the present invention.

Sixth, Applicants submit that the combination of Ansmann '978 and Akrongold '550 does not disclose or suggest all the limitations of the present invention. As such, no *prima facie* case of obviousness has been established, as one of ordinary skill in the art would not be able to arrive at the present invention from the combination of references.

Seventh, Applicants also submit that the Examiner is using impermissible hindsight to reconstruct the present invention. The Examiner merely relies on Applicants' own teachings to form the obviousness rejection. Neither reference suggests combining the references in a manner that might arrive at the present invention. Such hindsight reconstruction is impermissible according to MPEP 2141 and *In re Deminski*, 796 F.2d 436, 443 230 USPQ 313, 316 (Fed. Cir. 1986).

Eighth, at lines 6-7 from the bottom of page 3 of the outstanding office action, the USPTO states that one skilled in the

art would have been "motivated to teach" the esters of linear and/or branched fatty acids with polyhydric alcohols. This reasoning is not clear, and is submitted to mainly amount to unsupported statements of conjecture on the USPTO's part. Such an unsupported statement cannot properly support an obviousness rejection of the instant claims over the teachings of Ansmann and Akrongold.

Ninth, it is noted that there are no teachings or suggestions to make the instantly claimed combination in the cited art of Ansmann '978 and Akrongold '550, and no reasonable expectation for success is provided in the references for doing so. (*In re Vaeck*, see MPEP § 2143, p. 2100-125). Likewise, there is no motivation in the cited art to combine these two references. Without such motivation to combine, a rejection based on *prima facie* obviousness is improper. The level of skill in the art cannot be relied upon to provide a suggestion to combine the references. (*In re Rouffet, Al-Site Corp. v. VSI Int'l Inc.*, See MPEP 2143.01) In fact Ansmann '978 does not teach the esters of the instant invention, motivation, nor any suggestion to combine the references, contrary to the USPTO's assertions. The same can also be said of the Akrongold '550, which does not teach the esters of the presently

claimed invention, or provide any motivation or suggestion to combine the references in a fashion that might arrive at the invention as claimed.

Tenth, as to the USPTO's rejection of claim 21 as obvious over Ansmann '978 in view of Akrongold '550 in view of Bernhardt '054, Applicants rely on the arguments above regarding the failure of Ansmann '978 and Akrongold '550 to disclose or suggest all the elements of the present invention and the Examiner's use of impermissible hindsight.

Eleventh, Bernhardt '054 discloses a sunscreen containing cosmetic oil, such as fatty acid esters. Bernhardt '054 discloses at column 7, lines 4-12, esters that are esters of fatty acids with at least one hydroxyl group containing compound 1 mono- di- and tri- alkanols, each containing less than 7 carbon atoms per molecule, such as mixed glycerides, vegetable oils, isopropyl palmitate and isopropylmyristate. However, these esters are also outside the scope of the esters of the present invention. Thus, while Bernhardt et al. may also teach rosin, its disclosure when combined with the remaining cited art references does not cure the above noted deficiencies of Ansmann '978 and Akrongold '550. As such, one of ordinary skill in the art would not be able to arrive

at the present invention from the combination of references. Thus, the rejection should be withdrawn.

Conclusion

As Applicants have addressed and overcome all rejections in the Office Action, Applicants respectfully request that the rejections be withdrawn and that the claims be allowed.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact the undersigned at the telephone number indicated, to conduct an interview in an effort to expedite prosecution in connection with the present application.

Appl. No. 09/604,763

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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Attachments: Table 1 with 11 documents;
International Cosmetics Ingredient Dictionary, Vol. 210, pages 488-489, 521-522 (1993).

(Rev. 02/20/02)